

REMARKS

By this Amendment, Applicants have amended claims 24-30, 32-34, and added claims 37-45. The amendments to the claims and the newly added claims are supported by the application as originally filed, and do not introduce new matter. The amendments to the claims are made for clarification purposes only and are not intended to limit the scope of the claims. Accordingly, entry of the amendments is respectfully requested.

Information Disclosure Statement

The Examiner asserts that the Information Disclosure Statement filed October 8, 2004 includes a reference without the date of publication. An Information Disclosure Statement re-introducing the references previously cited, including the date of publication, is filed concurrently herewith. Entry is respectfully requested.

Claim Rejections – 35 U.S.C. §101

Claims 24-31 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The Applicants respectfully traverse. Independent claim 24 and dependent claims 25-31, even before amendment, produce a useful, concrete, and tangible result which is all that is required to satisfy 35 U.S.C. §101. *See, e.g., State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). For example, in claim 24 a file representing at least one product from a product database is selected. In order to expedite the prosecution of this application, however, the Applicants by this amendment have clarified that claim 24 and the claims dependent thereon are computer implemented and use a computer for obtaining at least one file representing at least one product. Accordingly, withdrawal of the rejection under 35 U.S.C. §101 is respectfully requested.

Claim Rejections – 35 U.S.C. §112

Claims 25, 26, 28, and 30 are rejected under 35 U.S.C. §112 as being indefinite.

With regard to claim 25, the Examiner asserts that it is unclear if the list of items recited is conjunctive or disjunctive. Claim 25 as amended recites “the file is at least one of a link, a document, and a thumbnail.” In this respect, the items are not necessarily disjunctive. That is, a file may be a thumbnail and a link.

With regard to claim 26, the Examiner asserts that the term “statically associated” is indefinite. Claim 26 as amended provides that “the file is statically associated with the web page” rather than the keyword being statically associated with the web page. *See, e.g.*, Application, ¶¶10-12.

Claims 28 and 30 have been amended to correct the informalities objected to by the Examiner. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. §112 is respectfully requested.

Claim Rejections – 35 U.S.C. § 102 and §103

Claims 24-34 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,933,811 to Angles *et al.* (“Angles”) or by U.S. Patent No. 5,948,061 to Merriman *et al.* (“Merriman”). In the alternative, claims 24-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Angles. Claim 33 is cancelled. The Applicants respectfully traverse the rejections, and assert that the claims pending in the present application and the newly added claims are patentable over Angles and Merriman for at least the reasons stated below.

Angles discusses methods for targeting advertisement to Internet users by “stor[ing] demographic information about consumers, and send[ing] customized advertisements to the consumers based on the consumers demographic profile.” *See, e.g.*, col. 3, lines 8-12; col. 8, lines 57-61; col. 13, lines 8-54; and col. 15, lines 20-24. Merriman similarly provides targeted advertising based on user profiles. *See, e.g.*, col. 4, lines 25-29 and col. 5, lines 64-66. Neither Angles nor Merriman teaches, discloses or suggests either separately or in combination analyzing a web page to obtain at least one first keyword associated with the web page as is recited in independent claims 24, 32 and 34.

The Examiner asserts at page 6, item 15, of the Office Action that Angles discloses the claimed invention and sets forth a series of parenthetical expressions written next to each element of claim 24 without any indication to wherein Angeles the phrases may be found. First, a thorough review of Angles reveals that none of the terms used by the Examiner in the parenthetical phrases, such as “widget,” “price,” “table,” “downloading,” and “saving,” appear in Angles. Second, the parenthetical expressions proffered by the Examiner does not teach, disclose or suggest analyzing a web page to obtain at least one first keyword associated with the web page. Accordingly, withdrawal of the rejections under 35 U.S.C. §102 and §103 is respectfully requested.

At page 7, item 18, of the Office Action asserts that “it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Angles to include downloading a file such as a user manual in PDF form.” *See* Office Action dated March 22, 2005, at page 7. The Examiner provides no motivation to modify Angles as is required under MPEP §706.02(j). Moreover, the Examiner does not cite to any prior art reference describing what is meant by “PDF”. If the Examiner is referring to Adobe’s Portable Document Format, there are numerous articles referencing this format and without providing the Applicants with at least one of those references, the Applicants cannot respond and a prima facie case of obviousness cannot be made. Even if modified, as the Examiner suggests, Angles still fails to teach, disclose or suggest analyzing a web page to obtain at least one first keyword associated with the web page as is recited in independent claims 24, 32 and 34.

Dependent claims 25-31 depend from independent claims 24, 32 and 34 and include additional recitations therein. Accordingly, withdrawal of the rejections under 35 U.S.C. §102(e) and §103(a) with respect to dependent claims 24-32 and 34 is respectfully requested.

At page 7, item 19, of the Office Action, the Examiner alternatively rejects claim 34 under 35 U.S.C. §103(a) as being unpatentable over Angles or Merriman and further asserts that “[b]ecause Invention I is not patentably distinct from Invention II and because Invention II is not patentably distinct from Invention I, the patentability of Invention II stands or fails with the patentability with Invention I.” *See* Office Action dated

March 22, 2005, at page 7. The Examiner does not explain which claim or claims “Invention I” and/or “Invention II” refer to; nor does he provide a basis for the foregoing assertion. The Applicants respectfully request that the Examiner either issue a Notice of Allowance or provide this information so that Applicants may respond. Accordingly, withdrawal of the rejection of claim 34 under 35 U.S.C. §103(a) is respectfully requested.

Claim Term Definitions

At pages 7-13, items 20 and 21 of the Office Action, the Examiner sets forth a number of definitions that appear to relate to elements in pending claims. The Applicants agree that the Examiner should give the claim terms their broadest reasonable interpretation when comparing against prior art. However, the terms referenced in the Office Action may or may not be defined as suggested by the Examiner. The Applicants note that it is inappropriate to even consider a definition for those terms at this time as none of the terms form a basis for any of the outstanding rejections. The foregoing statement by the Applicants should not be construed as the Applicants’ admission of any sort as the Applicants expressly reserve the right to a proposed interpretation of any claim terms, should it become necessary or desirable to do so.

Level of Skill in the Art

At pages 14-15, items 27 and 28 of the Office Action, the Examiner cites a number of references presumably to define the level of one of ordinary skill in the applicable arts. The Applicants take no position on whether the cited references accurately define the level of one of ordinary skill in the applicable arts for the following reasons. The cited references do not form a basis for any of the stated rejections. Further, the Applicants have not had an opportunity to review the cited references and respectfully request that the Examiner provide a copy of each cited reference to the undersigned so that undersigned may review the contents therein. *See, e.g.*, MPEP §609. Applicants expressly reserve the right to further object to the Examiner’s interpretations and characterizations of the cited references should it become necessary or desirable to do so. Additionally, the

issue for determining the level of one with ordinary skill in the art is not ripe and it is inappropriate to do so at this time.

CONCLUSION

For the foregoing reasons, the Applicants submit that the invention as claimed is patentable over the references cited by the Examiner. Accordingly, reconsideration and allowance of pending and newly added claims are respectfully solicited. The Examiner is kindly invited to contact the Applicants' undersigned representative to expedite prosecution.

Respectfully,

Dated: September 20, 2005

I hereby certify that the correspondence attached herewith is being deposited this date with the U.S. Postal Service as First Class Mail with sufficient postage addressed to Mail Stop: Amendments, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.


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Date



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